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IN THE

Supreme Court of the United States

OCTOBER TERM, 1946.

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No. 120.
—

BENJAMIN WAITE BLANCHARD, JR., *Petitioner*,

v.

CASPER W. OOMS, COMMISSIONER OF PATENTS, *Respondent*

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REPLY BRIEF FOR PETITIONER.
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J. PRESTON SWECKER,
Attorney for Petitioner.

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REPLY BRIEF FOR PETITIONER.

This is in reply to the Brief for the Respondent in opposition to the Petition for a Writ of Certiorari, to correct what appear to be erroneous statements or inferences presented in the Argument for the Respondent.

The questions presented on the petition are concerned solely with questions of law, as to whether the rule applied by the Court below was correct in such cases and consistent with the practice of the Patent Office and of the Courts. If it was not, the case should be reversed and remanded for a new trial, when the proper and applicable rule may be applied.

It is asserted on page 4 of the respondent's brief, consistent with the questions as stated on page 2 thereof, that the primary question is whether the petitioner's claims constitute invention. The primary question raised by the petition, however, is one of law, and the Court is not called upon to determine the fact question as to the relation of this invention to the prior patents.

The suggestion is made further, on page 3 of the respondent's brief, that the Examiner requested applicant to demonstrate his device, and such a demonstration was made but was not refused, as erroneously stated. The numerous affidavits in the Record show that a demonstration was had of this device. These were filed in accordance with Rule 76 of the United States Patent Office (see page 23 of the petition). Such affidavits are the only means available for presenting evidence to the Patent Office relevant to pending applications.

The extensive demonstration that was conducted before the numerous witnesses whose affidavits were filed in accordance with the Patent Office Rules shows that petitioner has not refused to demonstrate his device. Moreover, it was demonstrated in the District Court where, as the Record shows, it accomplished all of the results claimed for it by petitioner.

It is particularly significant that the District Court made no finding of fact that would indicate any lack of satisfaction in the demonstration. Because of the importance of the question raised by the Court of Appeals, the District Court's failure to make any finding on the tests conducted in open court is particularly significant and reason enough for reversing the decision in the interest of securing a finding by the District Court on this subject.

The brief for the respondent asserts repeatedly that applicant's claims are directed merely to a new combination of old elements. There is no finding by the District Court that applicant's elements are old individually. This is not important, however, because the subject matter of the claims is patentable as a new combination, whether the elements are new or old. *Hailes v. Van Wörmer*, 87 U. S. 353, 368; *Loom Co. v. Higgins*, 105 U. S. 580; *Leeds & Catlin v. Victor Talking Machine Co.*, 213 U. S. 301; *Expanded Metal Co. v. Bradford*, 214 U. S. 366.

That applicant's combination is new has not been questioned by any tribunal either in the Patent Office or in

Court. The sole reason for refusing patentability is asserted by the Court of Appeals to be that applicant has not shown by a test of comparative utility with the specific devices shown in the patents, that applicant's antenna has superior qualities. The issue raised by the petition is whether or not this requirement was proper.

Only one decision was cited by the Court of Appeals in its opinion in support of its requirement for a test of comparative utility. This decision was not applicable as was pointed out by the petitioner in his brief. It has been abandoned as any authority by the respondent, and is not even referred to in the respondent's brief, an admission that it is not applicable.

On the other hand, the only authorities cited by the respondent in an attempt to support the requirement of the Court of Appeals are two decisions on the question of infringement. Both of these decisions require, to prove infringement, a comparison of the patent in suit with the accused machine. That is the usual test of infringement. It is not relevant, however, to the question of patentability of an admitted new invention as compared with prior paper patents that do not even claim to accomplish the same results here demonstrated. Those cases have no relevance to the issues here involved.

The Patent Office does not require tests of the kind called for by the Court of Appeals. Such a requirement would be very unfair if imposed on all applicants for patents, because it would require the building for test purposes of the patented structures which are not in commercial use. That is an unreasonable requirement. To impose it on this applicant is a discrimination that should not be approved.

Respectfully submitted,

J. PRESTON SWECKER,
Attorney for Petitioner.

Washington, D. C.,
September 26, 1946.